



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: David Chao
SERIAL NO.: 10/037,687
FILING DATE: January 3, 2002
ATTNY. DOCKET: 62188.015202
TITLE: CONTAINERS WITH ADDITIONAL FUNCTIONALITY

REGULAR MAIL CERTIFICATE

Date of Deposit: October 29, 2003

I hereby certify that the following attached paper(s) and/or fee

- (1) A Response to Office Action of 5/30/03;
- (2) Petition for Extension;
- (3) Fee transmittal authorizing deduction \$210 from Deposit account 502458
- (4) A self-addressed stamped postcard, return of which is requested to acknowledge receipt of the enclosed documents

are being deposited with the United States Postal Service Regular Mail Post Office to Addressee service under 37 C.F.R. Section 1.10 on the date indicated above and is addressed to Mail Stop Non-Fee Amendment; Commissioner for Patents, P.O. Box 1450; Alexandria, VA 22313-1450.

Respectfully submitted,
GREENBERG TRAURIG, LLP.

ms. Randi Flamenbaum
Legal Assistant

29 Oct 03
Dated: October 29, 2003

CORRESPONDENCE:

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Applicant (s): David Chao

Application: 10/037,687

Filed: 01/3/2002

Title: CONTAINERS WITH ADDITIONAL FUNCTIONALITY

Receipt is hereby acknowledged by return of this postal card properly stamped by the US PTO for the above noted matter of the following:

- (1) A Response to Office Action of 05/30/03;
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Attorney: BJS/MT/rsf

Docket No. 62188 013705



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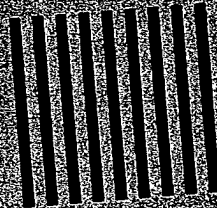
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PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

Docket Number (Optional)

06878-011022-7056 020A 62,588,015,21

In re Application of David Chao

Application Number 10/037,687

Filed 01/03/2002

For CONTAINERS WITH ADDITIONAL FUNCTIONALITY

Group Art Unit 3728

Examiner
Jila M. Mohandesi

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

☐ One month (37 CFR 1.17(a)(1))

\$ _____

☒ Two months (37 CFR 1.17(a)(2))

\$ 420

☐ Three months (37 CFR 1.17(a)(3))

\$ _____

☐ Four months (37 CFR 1.17(a)(4))

\$ _____

☐ Five months (37 CFR 1.17(a)(5))

\$ _____

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ 210

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 502458

I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor

☐ assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ attorney or agent of record.

☐ attorney or agent under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a) _____

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October 29, 2003

Date



Signature

Barry J. Schindler, Reg. No.: 32,938

Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 210

Complete if Known

Application Number 10/037,687

Filing Date January 3, 2002

First Named Inventor David Chao

Examiner Name Jila M. Mohandesi

Art Unit 3728

Attorney Docket No. 62860, 610503, 62188, 015202

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number
Deposit Account Name

502458

GREENBERG TRAURIG LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)			(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	210
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 210

SUBMITTED BY

Name (Print/Type)	Registration No. (Attorney/Agent)	Telephone
Barry J. Schindler	32,938	212-801-224
Signature	Date	
	10/29/2003	

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): David Chao	:	Group Art Unit: 3728
Serial No.: 10/037,687	:	Examiner: Jila M. Mohandesi
Filed: January 3, 2002	:	Attorney Docket No.: 62188.015202
For: CONTAINERS WITH ADDITIONAL FUNCTIONALITY	:	

AMENDMENT IN RESPONSE TO MAY 30, 2003 OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS:

This Amendment is filed in reply to the Office Action issued by the U.S. Patent and Trademark Office on May 30, 2003 in connection with the above-identified patent application. The May 30, 2003 Office Action provided a period of 3 months in which to file a response, i.e., by August 30, 2003. A petition for a two-month extension of time is being filed concurrently herewith. Accordingly, a reply to the May 30, 2003 Office Action is now due October 30, 2003 and this Amendment is being timely filed.

AMENDMENTS TO THE CLAIMS:

Please amend claims 13, 14 and 16 as follows and cancel claims 15 and 17, without prejudice or disclaimer.

13. (Currently Amended) A container for storing ~~items~~ an item, which container is comprised of a body defining an interior space for storing ~~items~~ the item, an opening through which the ~~items~~ item can be stored in the body and removed therefrom, a closure ~~that~~ element having a ~~first~~ an open position permitting access to the ~~first~~ interior space and a ~~second~~ closed position closing the ~~second~~ interior space, and a video gaming device located on the container, wherein the stored item is a pair of eyeglasses.

14. (Currently Amended) The container of claim 13, wherein the opening is closed with a the closure element ~~that closes the opening of the container.~~

15. (Cancelled)

16. (Currently Amended) A container for storing ~~items~~ an item, which container is comprised of a body ~~comprised of~~ including a first portion and a second portion, wherein the first portion and the second portion are joined together at a hinge, the first portion and the second portion defining an interior space for storing ~~items, that, the item, and a video gaming device~~ located on the container, wherein the container has an open state and a closed state such that when the container is in the open state, permits access to the interior of the body space is permitted, and when the container is in the closed state, closes the interior space is closed-off, and ~~a video gaming device located on the container~~ wherein the stored item is a pair of eyeglasses.

17. (Cancelled)

REMARKS:

Claims 13, 14 and 16 are presented for examination, with claims 13, 14 and 16 having been amended hereby and claims 15 and 17 having been cancelled, without prejudice or disclaimer.

Reconsideration is respectfully requested of the rejection of claims 13 and 14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In this regard, it is noted that independent claim 13 has been amended hereby to address the “a closure that having” and “interior space” wording discussed by the Examiner.

It is further noted that the rejection of claim 15 has been rendered moot by its cancellation hereby and that claim 14 had apparently been rejected based solely on its dependence from claim 13.

Accordingly, it is respectfully submitted that the rejection of claims 13 and 14 under 35 U.S.C. §112, second paragraph, has been overcome.

Reconsideration is respectfully requested of the rejection of claims 13, 14 and 16 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,478,330 (“Lin ‘330”).

As the Examiner points out in paragraph 6 of the above-mentioned Office Action, “Lin ‘330 is silent about storing a pair of eyeglasses”.

Since independent claims 13 and 16 have been amended hereby to explicitly recite storage of a pair of eyeglasses, it is respectfully submitted that Lin ‘330 clearly fails to anticipate these claims, as amended.

Moreover, since claim 14 depends from claim 13, it is respectfully submitted that Lin ‘330 likewise clearly fails to anticipate this claim.

Therefore, it is respectfully submitted that the rejection of claims 13, 14 and 16 under 35 U.S.C. 102(b) as being anticipated by Lin ‘330 has been overcome.

Regarding the rejection of claims 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Lin ‘330 in view of U.S. Patent 6,145,986 (“Conner ‘986”), it is respectfully submitted that the cancellation of these two claims has rendered their rejection moot.

However, since claims 13 and 16, as amended, essentially recite the subject matter of now

cancelled claims 15 and 17, in order to expedite prosecution of the application a few comments directed to the Examiner's now moot rejection of claims 15 and 17 will now be made.

More particularly, it is respectfully submitted that it would not, in fact, have been obvious to store a pair of eyeglasses in the container of Lin '330 as proposed by the Examiner in paragraph 6 of the above-mentioned Office Action.

In fact, a studied analysis of Lin '330 reveals that this reference actually teaches away from the storage of such eyeglasses. This is because an explicit object of the Lin '330 container invention is "to provide a versatile pocket-size container which is slightly larger than a cigarette case". (see Col. 1, lines 19-21) (emphasis added). As the Examiner will no doubt appreciate, such a small container is clearly not suitable for storing a pair of eyeglasses.


Accordingly, it is respectfully submitted that each rejection raised by the Examiner in the May 30, 2003 Office Action has been overcome and that the above-identified application is now in condition for allowance.

Favorable reconsideration is earnestly solicited.

Dated: October 29, 2003

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Respectfully submitted,
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